

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No : **10/620,038**
Applicant : **Shimek et al.**
Filed : **July 15, 2003**
Title : **Soft Dried Marshmallow and Method of Preparation**

TC/A.U. : **1794**
Examiner : **Bekker, Kelly Jo**

Docket No. : **6126US**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants of the above-identified U.S. patent application submit this Pre-Appeal Brief Request for Review in response to the January 12, 2009 final rejection of claims 1, 3-27, 29-39 and 81 in this application. A Notice of Appeal and the requisite fee accompanies this request.

ARGUMENTS

The Examiner's refusal to accept the February 27, 2008 Affidavits and evidence in support of the Affidavits submitted October 23, 2008 under 37 C.F.R. 1.131 was in clear error. The Affidavits establish invention prior to the effective date of U.S. Patent Publication No. 2004/0109933 to Roy et al. and are accompanied by evidence as required by the Patent Rules.

As set forth in M.P.E.P. § 715, when any claim of an application is rejected, the inventor of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference. The showing of facts necessary to establish such prior invention shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained. See 37 C.F.R. § 1.131.

The February 27, 2008 affidavits provided an appropriate declaration from inventors Susan L. Kamper and James W. Geoffrion that establishes invention of the subject matter of at least claim 1 prior to the effective date of U.S. Patent Application Publication No. 2004/0109933 to Roy et al. (i.e., October 31, 2003). In particular, Susan L. Kamper states that samples of the claimed product were tested in the summer of 2002, while James W. Geoffrion confirms that the claimed product was reduced to practice and slated for consumer testing in 2002. Further evidence of the reduction to practice was provided, also in affidavit form, in the response of October 23, 2008, and will be discussed in more detail below.

Claim 1 of the present invention is directed to a dried soft aerated confection comprising about 65%-98% of a saccharide; about 0.05-15% of a foaming agent; about 0.5-20% of a structuring agent; 1-10% moisture, at least one color, a density of about 0.1-0.35g/cc, a water activity from about 0.1-0.4, about 5-25% of a softening agent and a springback factor of a minimum of 20%-50%.

By way of example, page 2 of the prior submitted evidence shows a marbit batch including sugar at 93.95% of a base slurry and 57.91% of a sugar slurry (which are combined during marbit production), hydrated gelatin (foaming and structuring agent) at 6.05% of the base slurry, and moisture level of between 1.16 and 12.9 as shown on page 4. Glycerin (softening agent) was added to the mixture at 6.7-15% as shown on page 3 of the evidence. The water activity levels shown on page 4 of the evidence range from 0.101-0.071. Pages 5-6 of the evidence discuss the physical characteristics of the marbit, i.e., soft or chewy at low water activity.

Presently, claims 1, 3-9, 14, 15, 32, 38 and 81 stand rejected by the Examiner under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 204/0109933 to Roy et al. The Examiner has not accepted the § 1.131 affidavits and accompanying evidence because, according to the Examiner, the affidavits do not “establish possession of whole invention as claimed or something falling within the claim (such as a species of a claimed genus) . . .”

More specifically, on page 4 of the Office Action, the Examiner states that the affidavit does not include a marbit that *does not require fat* and that comprises 0.05 – 15% foaming agent, 0.5-20% structuring agent, moisture content of 1-10%, and water activity of .1-.5 and/or 5-25% of a softening agent as instantly claimed. The Applicant respectfully traverses this position. Currently, claim 1 *can* include fat since the claim is open ended by using the transitional word “comprising.” It is not until claim 9 that the amount of fat is limited to less than 5%. Therefore, it is unclear why the Examiner indicates the affidavit must show an example without fat. It does not make sense that the Examiner is mandating the evidence to show what the product of the invention does not

require. The water activity as claimed ranges from about 0.1 to about 0.4. The Examiner appears to allege that the water activity of the disclosed marbit is 0.25. Actually, the affidavit references marbits having a water activity between 0.101 and 0.171, while referencing that the cereal can have a water activity of 0.25. Certainly, the Examiner's earlier requirement of possession of at least a species of a claimed genus is met.

Referring specifically to batch 33-44, a marbit is shown including a sugar slurry and a hydrated gelatin. The sugar slurry includes sugar, corn syrup, dextrose and water, while glycerin is added thereto. Corn syrup is added at an optimum level of about 10%. It is totally inconsistent for the Examiner to consider Roy et al. to read on claim 1 because Example 1 of Roy et al. teaches 0.1% water, 89.22% of a sucralose solution and 5.7% of a gelatin solution which may contain 11% glycerin, yet be of the opinion that the composition disclosed in the affidavit does not.

As set forth in M.P.E.P. § 715.07, the ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. *In re Blake*, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Respectfully, the Applicant submits that the evidence produced in combination with the inventor's sworn statements is beyond sufficient to prove reduction to practice before the critical date such that Roy et al., which is commonly assigned with the application, is not effective prior art.

The Applicant also maintains that the present invention is patentably distinct over Roy et al. for at least the reasons presented in the amendment/response dated October 23, 2008. In particular, Roy et al. modified by "216 Zietlow et al. cannot possibly establish a soft marshmallow having the minimum 20-50% springback factor claimed given that Zietlow et al. specifies a "dried, crisp, frangible marshmallow." Regardless, the Applicant submits that the Pre-Appeal board need not review this error as the sworn affidavits effectively remove all prior art rejections.

Based on the above remarks, the Applicant respectfully submits that the present invention is clearly patentable over the prior art of record.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "EG Diederiks Jr", written over a horizontal line.

Everett G. Diederiks, Jr.
Attorney for Applicants
Reg. No. 33,323

Date: April 27, 2009
DIEDERIKS & WHITELAW, PLC
12471 Dillingham Square, #301
Woodbridge, VA 22192
Tel: (703) 583-8300
Fax: (703) 583-8301